

## REMARKS

Entry of the amendments to the claims and specification, and consideration of the following remarks are respectfully requested. Upon entry of the amendments, this application will contain claims 63-106 pending and under consideration. Claims 63-106 were rejected under 35 U.S.C. §102(e) over Bianchi et al. (U.S. 6,033,438). For at least the reasons discussed below, it is believed that the claimed invention is patentable over the cited art. Reconsideration leading to timely allowance of this application is requested.

### Claim Amendments

The claims pending prior to this submission contained two claims numbered 93. Therefore, the duplicate claim 93 and original claims 94-105 have been renumbered as 94-106.

### Claim of Priority

It was suggested in the latest Office Action that the first paragraph of the specification be amended to specifically indicate the relationship between the present application and the prior applications. Additionally it was alleged that a new declaration was required.

The Applicants have submitted a Petition to Accept an Unintentionally Delayed Priority Claim concurrent with this Response, along with authorization to charge the statutory fee for the Petition to the American Express account number shown on the enclosed form (PTO-2038).

It is believed that the declarations of the inventors submitted on September 14, 2001 (signed by three of the inventors) and on September 25, 2001 (signed by a fourth inventor) each submission accompanied by a copy of the formalities letter and the fee for an extension of time to respond to the Notice of Missing Parts conform to the requirements of 37 CFR §1.63. Consequently, it is believed that new declarations are not required.

### Rejections under 35 U.S.C. 102

Claims 63-106 were rejected under 35 U.S.C. §102(e) over Bianchi et al. Applicants respectfully traverse this rejection. It is believed that Bianchi et al. does not disclose or make obvious the presently claimed invention.

In the latest office action, it was argued that Bianchi et al. disclose a spinal fusion implant comprising an elongate bone portion defining a longitudinal axis, and having a generally rectangular cross-section transverse to the longitudinal axis; as set forth in column 8, lines 43-51. (Office Action, page 3)

It is believed that Bianchi et al does not disclose a spinal fusion implant that has a generally rectangular cross-section lying transverse to the longitudinal axis, *i.e.*, when viewed from a direction parallel to the longitudinal axis. First, each of the implants illustrated in Figs. 1, 2, 3, 4, 5, 6, 8, 9, 10, 11, 12, 13, 14, 16, 16A-D, 28, 29, 30, 31, 35, 36, and 37 are illustrated as dowels having rounded, or curved sidewalls that extend along the longitudinal axis. Second, the portion of the text cited in the Office Action states:

"In some embodiments, the wall 506 may include upper and lower flattened portions to stabilize the dowel by neutralizing any rotational torque that may be induced by pressure on the sidewall. This could be achieved by reducing the height H of the sidewall 505 and ends 501 and 502 by filing or like means. These considerations may be less important for a threaded dowel and a non-threaded dowel as the threads tend to 'bite' into the bone in which they are implanted, thereby preventing any rotation." (Bianchi et al. col. 8, lines 43-51.)

The sidewall 506 cited in this passage identifies the sidewall of implant 500 illustrated in Figs. 4. As noted above, this implant is illustrated as a dowel having a rounded or curved sidewall 506. Flattening the upper and lower surfaces of sidewall 506 will still leave the remaining portions of the sidewall with rounded or curved surfaces. The resulting implant does not have a rectangular cross section transverse to the longitudinal axis as suggested in the Office Action. At best the cross section transverse to the longitudinal axis of implant 500 could be described as having flat or straight upper and lower edges and curved edges disposed between the upper and lower edges.

Third, Bianchi et al. does not disclose or make obvious the invention as presently claimed including a spinal fusion implant comprising, *inter alia*, "an elongate bone portion defining a longitudinal axis and having a generally rectangular cross-section transverse to the longitudinal axis". Applicants request withdrawal of the rejections of claim 63 and claims 64-81 and 89-93, which depend from claim 63.

Applicants do note, however, that the claims in Bianchi do not contain such limitations and should not be interpreted limited solely to the specific embodiments illustrated in the patent. *In re Smythe*, 178 USPQ 279, 285 (CCPA 1973), *In re Rasmussen*, 211 USPQ 323, 326, 327 (CCPA 1981), and *Dennison Manufacturing Company v. Ben Clements and Sons, Inc.*, 203 USPQ 895, 906 (DC SNY 1979).

Claim 82 recites that the second, opposite sidewall is "generally parallel to the concave surface" of the first wall. It was argued in the latest Office Action that Bianchi et al. in Fig. 16 illustrates an elongate bone portion defining a longitudinal axis, and as best seen in Fig. 13, comprising a first side wall comprising a concave surface and a second side wall comprising a convex surface. It is respectfully suggested that this misinterprets the Figures and text of Bianchi. As noted above each of the Figures including Figs. 13 and 16 illustrate a dowel having a rounded or curved sidewall. The dowels are cylindrical bone plugs with a concavity formed in one side. The concave surface cannot be parallel to the convex, cylindrical sidewall as claimed in the present application.

It is believed that Bianchi et al. does not disclose or make obvious an implant having a second wall that is generally parallel to the concave surface in the first wall. Consequently, withdrawal of the rejections over claim 82 and claim 83, which depends from 82 is requested.

Independent claims 84 and 94 each recites that the bone portion defines a "longitudinal axis having a generally rectangular cross-section transverse to the longitudinal axis". As noted above, it is believed that Bianchi does not disclose an implant as presently claimed. Consequently, withdrawal of the rejections over claim 84 and claims 85-88, which depend from claim 84; and of the rejections over claim 94 and claims 95-106, which depend from claim 95, is requested.

### Conclusion

In view of the foregoing remarks, the Applicants respectfully submit that the cited reference does not disclose or make obvious the claimed invention. Accordingly, reconsideration leading to withdrawal of all the rejections under 35 U.S.C. §102(e) and passage of this application containing claims 63-106 are respectfully requested. In addition, the Examiner is invited to telephone the undersigned attorney if there are any questions about this

submission or other formal matters, which may be addressed in that fashion to facilitate allowance of this application.

Respectfully submitted,

By: James B. Myers  
James B. Myers Jr., Reg. No. 42,021  
WOODARD EMHARDT MORIARTY  
McNETT & HENRY LLP  
3700 Bank One Center Tower  
111 Monument Circle  
Indianapolis, IN 46204-5137  
(317) 713-4948